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09/856,403	07/27/2001	Gerold Tebbe	011105	9180

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FACTOR & LAKE, LTD  
1327 W. WASHINGTON BLVD.  
SUITE 5G/H  
CHICAGO, IL 60607

EXAMINER
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LEWIS, KIM M

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 04/07/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/856,403

Applicant(s)

TEBBE, GEROLD

Examiner

Kim M. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,4-11 and 13-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-11, 14-27, 29-42, 44-56 and 58-62 is/are rejected.
- 7) ☒ Claim(s) 13, 28, 43 and 57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: Detailed Action.

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed on 1/22/04 has been received and made of record in the application file wrapper. Claims 1, 4,-11, 13-18 have been amended, claim 3 and 12 have been canceled, and claims 19-62 have been added.
2. Claim 1, 4-11 and 13-62 are pending in the instant application.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,094,316 ("Nathanson").

As regards claim 1, Nathanson discloses an adhesive bandage with reusable appliqué that reads on applicant's instant claim. More specifically, Nathanson discloses a plaster (bandage 10) having a base layer (tape 14), working layer (pad 18) and an adhesive layer (16), whereby an external surface of the base layer remote from the adhesive layer is formed in such a way that it is **capable** of accepting a cosmetic preparation, and wherein further the external surface of the base layer is rough in that it

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is constructed from woven textile fabric, and includes a surface coating (appliqué 30) constructed from cotton denim, which is inherently hydrophilic (col. 4, lines 4).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 4, 10, 15, 16, 18, 19, 20, 26, 30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,120,325 ("Dow, Jr.") in view of U.S. Patent No. 4,713,280 ("Williams").

As regards claim 1, Dow, Jr. substantially discloses all features of the claim including a backing layer having top and bottom sides, a working layer (absorbent pad), an adhesive layer applied to the bottom side of the backing layer, and a non-toxic pigmented composition (cosmetic composition in that it serves to correct physical imperfections) coated onto or embedded into said top side of said backing layer (col. 2,

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lines 10-21). Dow, Jr. further teaches a rough surface in the form of folds and grooves to simulate the texture of human skin on the external surface of the backing layer (col. 2, lines 40-44).

Dow, Jr. fails to teach in addition to the rough surface one of a surface treatment and a surface coating so that the external surface is either lipophilic or hydrophilic. However, Williams discloses a film having a backing provided with an absorbent hydrophilic surface coating for purpose of absorbing material used thereon for inking, printing images, etc. (col. 1, line 58-col. 2, line 2).

In view of Williams, it would have been obvious to one having ordinary skill in the art to modify Dow, Jr. with the addition of a hydrophilic coating on the backing layer, as taught by Williams, in order to allow the non-toxic pigmented composition to be easily absorbed by the backing layer.

As regards claim 4, the external surface exhibits an imprint with a skin pattern (col. 1, lines 44-49 and col. 2, lines 40-44).

As regards claim 10, Dow, Jr. fails to teach that the thickness of base layer amounts to between 20 and 100  $\mu\text{m}$ , preferably 30 to 60  $\mu\text{m}$ . Absent a critical teaching and/or a showing of unexpected results derived from providing the thickness of the backing layer in an amount between 20 and 100  $\mu\text{m}$ , preferably 30 to 60  $\mu\text{m}$ , the examiner contends that the thickness of the backing layer is an obvious design choice which does not patentably distinguish applicant's invention.

Additionally, the examiner further contends that one having ordinary skill would

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have been motivated to provide a thin backing layer in order to the backing layer inconspicuous.

As regards claim 15, it is inherent in the disclosure of Dow, Jr. that the adhesive is constantly tacky. Additionally, Dow, Jr. discloses at col. 2, lines 63-66 that a peelable protective layer can be applied to the adhesive layer to prevent premature adhesion of the bandage. This protective layer reads on the backing layer of the present invention.

As regards claims 16 and 18, Dow, Jr. fails to teach drying agents in the form of kieselguhr and aluminum oxide, and skin care products in the form of soothing oils. Absent a critical teaching and/or a showing of unexpected results derived from providing the working layer with drying agents in the form of kieselguhr and aluminum oxide, and skin care products in the form of soothing oils, the examiner contends that the addition of any active substance to the bandage of Dow, Jr. is an obvious design choice, which does not patentably distinguish applicant's invention.

As regards claims 19 and 20, note the rejection of claims 1 and 4 above.

As regards claim 26, note the rejection of claims 10 and 19 above.

As regards claim 30, note the rejection of claims 15 and 19 above.

As regards claim 33, note the rejection of claims 18 and 26 above.

8. Claims 5, 6, 21, 22, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view Williams as applied to claim 1 above and in further view of U.S. Patent No. 3,797,494 ("Zaffaroni").

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As regards claims 5 and 6, the modified device of Dow, Jr. fails to teach that the absorbent layer (working layer) comprises at least one microencapsulated active substance. However, Zaffaroni discloses a bandage comprising a working layer (12) having uniformly distributed therein, microcapsules (13) comprising a drug (e.g., pharmaceuticals acting on the skin such as bacitracin and hydrocortisone) encapsulated with a microporous rate controlling material for the continuous administration of drugs to the skin or mucosa (abstract and col. 9, lines 54-66).

In view of Zaffaroni, it would have been obvious to one having ordinary skill in the art to modify the absorbent pad (working layer) of Dow, Jr. with the addition of microcapsules comprising a drug (e.g., encapsulated with a microporous rate controlling material for the continuous administration of drugs to the skin or mucosa.

As regards claims 21 and 22, note the rejection of claims 5, 6 and 19 above.

As regards claim 31, note the rejection of claim 16 and 22 above.

As regards claim 32, note the rejection of claim 17 and 22 above.

9. Claims 7, 8, 23, 24, 34, 35, 36, 39, 41, 45, 48-51, 55, 59 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow Jr. in view Williams as applied to claim 1 above, and in further view of U.S. Patent No. 2,905,174 ("Smith").

As regards claim 7, Dow, Jr. discloses the backing as having a flesh colored surface so as to conceal the wound dressing. The modified device of Dow, Jr. is deficient in disclosing the base layer as bearing a printing-ink layer. However, Smith teaches an adhesive bandage with a transparent film backing, in which the backing is

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provided with a series of cosmetic preparations in the form of flesh-colored markings (printing-ink layer) (col. 1, line 65-col. 2, line 29 and col. 4, lines 51-56) for the purpose of rendering the bandage less noticeable.

It would have been obvious to substitute the means for reducing the noticeability of a wound dressing, e.g., the melanin-like pigment composition, disclosed by Dow, Jr. for another means for reducing the noticeability of a wound dressing, e.g., the flesh-colored marking (printing-ink layer) as taught by Smith, since both means conceal an/or render the bandage less noticeable.

As regards claim 8, Smith discloses that the printing-ink layer is between the transparent backing and the adhesive layer (col. 4, lines 57-60). When the bandage of Doe, Jr. is modified to contain the printing ink layer, it too will have the printing-ink layer is between the backing and the adhesive layer.

Additionally, Dow, Jr. fails to teach a transparent backing; however, Smith teaches a transparent backing. One having ordinary skill in the art would be motivated to construct the backing layer from transparent material, as taught by Smith, in order to allow the bandage to blend into the skin.

As regards claim 23 and 24, note the rejection of claims 7, 8 and 19 above.

As regards claim 34, note the rejection of claim 1 and 7 above.

As regards claim 35, note the rejection of claim 4 and 34 above.

As regards claim 36, note the rejection of claim 1 and 34 above.

As regards claim 39, note the rejection of claim 8 and 34 above.

As regards claim 41, note the rejection of claims 10 and 34 above.



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As regards claim 45, note the rejection of claims 15 and 34 above.

As regards claim 48, note the rejection of claims 18 and 34 above.

As regards claim 49, note the rejection of claims 1 and 8 above.

As regards claim 50, note the rejection of claim 4 and 49 above.

As regards claim 51, note the rejection of claim 1 and 40 above.

As regards claim 55, note the rejection of claims 10 and 49 above.

As regards claim 59, note the rejection of claim 15 and 49 above.

As regards claim 62, note the rejection of claims 18 and 55 above.

10. Claims 9 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view Williams as applied to claim 1 above and in further view of U.S. Patent No. 4,702,237 ("Gianopoulos et al.")

As regards claim 9, Dow, Jr. fails to teach the backing layer is constructed from rubber. However, Dow, Jr. discloses at col. 2, lines 29-34 that "[t]he backing can be any inert flexible material..., or any other natural or synthetic polymer or fiber or any combination thereof."

Gianopoulos et al. teach it is conventional to construct bandages with latex rubber backing layers because latex rubber is flexible yet strong and does not irritate the skin.

In view of Gianopoulos et al., it would have been obvious to one having ordinary skill in the art to construct the bandage of Dow, Jr. with a latex rubber backing because latex rubber is flexible yet strong and does not irritate the skin.

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Additionally, the examiner wishes the applicant to note that it has been held that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Leshin*, 227, F.2d 197, 125 USPQ 416 (CCPA 1960).

As regards claim 25, note the rejection of claims 9 and 19. As regards claim 23 and 24, note the rejection of claims 7, 8 and 19 above.

11. Claims 11 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view Williams as applied to claim 1 above and in further view of U.S. Patent No. 4,618,519 ("Koch et al.").

As regards claim 11, Dow, Jr. fails to teach a curable adhesive. However, Koch et al. teach it is conventional to provide adhesive articles with a curable adhesive that cures at ambient temperature such that the article can cure *in situ* (abstract).

In view of Koch et al., it would have been obvious to one having ordinary skill in the art to modify Dow, Jr. by substituting the disclosed adhesive for a curable adhesive so that the bandage can cure *in situ*. This will allow proper placement of the article without premature adhesion of the article to an unwanted area on the skin.

As regards claim 27, note the rejection of claims 11 and 19 above.

12. Claims 14 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view Williams as applied to claim 1 above and in further view of U.S. Patent No. 4,807,753 ("Goldstein").

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Regarding claim 14, Dow, Jr. substantially discloses all features of the claim except a set comprising a plurality of bandages of various sizes. However, Goldstein teaches it is conventional in the art to provide a set comprising a plurality of bandages in order to fit various sized wounds.

In view of Goldstein, it would have been obvious to one having ordinary skill in the art provide the bandages of Dow, Jr. in a set comprising various sizes in order to fit various sized wounds.

As to the bandage being punched out of a planar material, the applicant should note that in a product claim, the method by which the product is formed is a non-distinctive characteristic, which does not serve to distinguish.

As regards claim 29, note the rejection of claims 14 and 19 above.

13. Claims 37, 38, 46, 47, 52, 53, 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view of Williams and Smith as applied to claims 34 and 49, above and in further view of Zaffaroni.

As regards claim 37, note the rejection of claim 5 and 34 above.

As regards claim 38, note the rejection of claim 6 and 37 above.

As regards claim 46, note the rejection of claims 16 and 38 above.

As regards claim 47, note the rejection of claims 17 and 38 above.

As regards claim 52, note the rejection of claims 5 and 49 above.

As regards claim 53, note the rejection of claims 6 and 52 above.

As regards claim 60, note the rejection of claims 16 and 53 above.

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As regards claim 61, note the rejection of claims 17 and 53 above.

14. Claims 40 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view of Williams and Smith as applied to claims 34 and 49 above, respectively, and in further view of Gianopoulos et al.

As regards claim 40, note the rejection of claims 9 and 34 above.

As regards claim 54, note the rejection of claims 9 and 49 above.

15. Claims 42 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view of Williams and Smith as applied to claims 34 and 49, respectively, and in further view of Koch et al.

As regards claim 42, note the rejection of claims 11 and 34 above.

As regards claim 56, note the rejection of claims 11 and 49 above.

16. Claims 44 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dow, Jr. in view of Williams and Smith as applied to claims 34 and 49 above, respectively, and in further view of Goldstein.

As regards claim 44, note the rejection of claims 14 and 34 above.

As regards claim 58, note the rejection of claims 14 and 49 above.

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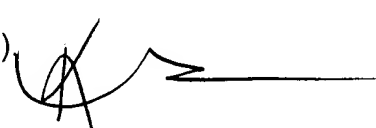
***Allowable Subject Matter***

17. Claims 13, 28, 43 and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703.308.0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Kim M. Lewis  
Primary Examiner  
Art Unit 3743**

kml  
April 4, 2005